

REMARKS

Claims 1, 3-47, 49-80, 82-103, 112-114 and 116-127 are pending and under consideration. Claims 12 and 13 have been amended to establish proper antecedent basis. Claims 112-113 are allowed.

Rejections Under 35 U.S.C. § 112

The Examiner rejected claims 13, 23-35, 56 and 89 as being indefinite. Claims 13, 23-35, 56 and 89 include a first game outcome that is unrelated to a second game outcome, which is further evidenced by the fact that the first and second games are different games altogether. Cards are discarded and replaced in the first game, whereas the second game includes the step of replacing any discarded prize indicia with randomly selected prize indicia. Although a variant of Applicants invention includes the ability to select certain cards in the first (primary) game, and thereby also get potential new replacement prize indicia in the second game for the respective discard. The second game still operates independently however. Each game is “unrelated” and “irrespective” of one another in that the *outcome* of the second game is separate and distinct from the outcome in the first game. Two or more game *outcomes* can be unrelated to one another even though the outcomes are determined by the same user interaction: same user interaction does not equate to related outcomes. For example, a player can achieve a prize award in the second game for matching indicia on the dealt (or replaced) cards irrespective of whether or not the player achieved a winning card hand, e.g., full house in a game of poker. Claims 13, 23-35, 56 and 89 do not set forth a contradictory relationship with respect to their independent claims. As described above, these claims are not indefinite.

Rejections Under 35 U.S.C. § 103

The Examiner rejected Claims 1, 3-12, 14-21, 36-39, 41, 43-47, 49-55, 57-82, 90-103, 114 and 116-127 under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 5,158,293 to Mullins (“Mullins”) in view of U.S. Patent No. 5,332,219 to Marnell II, (“Marnell”), in yet further view of U.S. Patent No. 6,749,500 to Nelson (“Nelson”). Reconsideration of the rejection is requested.

Applicants’ invention keys on the distinctiveness of two games of chance in the same gameplay, and their relative independence. The randomness used to select from the first set of symbols for the first set of positions in the primary game is independent of the randomness used to select from the second set of symbols for the second set of positions in the secondary game. The non-monetary award of the secondary game heightens the differentiation. What the player sees is the ability to simultaneously play two very different games, one non-monetary. Applicants’ invention heightens the player’s interest in the gaming machine in a new way.

Mullins is a lottery game that includes an instant win game, a jackpot drawing, and further, a bonus lottery drawing. (2:51-53, 3:56-57, 4:25-28). The instant win game of Mullins is played by simply scratching off removable material for a winning combination of letters. (2:54-65). The jackpot game lists a series of numbers that have to be matched to randomly selected numbers on a specified date. (3:58-65). The bonus lottery drawing is played with “any series of numbers on the jackpot half of the ticket that corresponds to a winning series on the instant-win half of the ticket”. (4:28-31). Mullins further describes two additional embodiments of the invention, both with instant play that corresponds to a jackpot play. (4:57-59, 5:17-18).

Mullins associates each instant-win game with a corresponding jackpot game, and each instant win game is played in combination with the jackpot game such that any jackpot game

corresponding to a winning instant game becomes a bonus game. (5:30-59). Unlike the present invention, Mullins' bonus game is played in a manner related to outcomes of the jackpot game and instant-win game: the bonus game is dependent on a jackpot game corresponding to a winning instant game. Applicant's invention is two separate and distinct games of chance with one game played in a manner unrelated to any outcome in the other game.

The Examiner argues the jackpot game is operated in conjunction with the instant win game and in a manner unrelated to any outcome in the instant win game (Office Action, p. 5), without considering the bonus game that is an aspect of Mullins' lottery game. Regardless, the printed sheet containing a predetermined result of Mullins is dramatically different from the gaming machine of Applicants' invention. Besides a first game that concludes to a monetary outcome and a second game that concludes to a non-monetary outcome, Mullins fails to disclose a game having the potential on every play thereof for achieving a prize award that is an aspect of Applicants' invention (Claims 1, 41, 47). It would be illogical for Mullins to have a win on each numbered game line of the instant game, or the same series of numbers on each numbered game line of the jackpot game. Mullins also fails to disclose a game with a reel display with a plurality of reels (Claim 36). The instant win game, jackpot game and bonus game of Mullins would be cumbersome to play on a reel-type gaming machine. Mullins also fails to disclose operating a game provided a wager is of at least a preset type (Claim 40) and registering an amount bet to award any winnings per a payable and said wager (Claim 96). The player of Mullins simply purchases the preprinted ticket for scratch-off play. (2:40-50). Applicants' invention generates results using a Random Number Generator (RNG) (Claim 96).

Marnell is a poker gaming apparatus to which the Examiner cites for teaching a lotto game incorporated with a gaming machine. (Office Action, p.6). Mullins and Marnell do not teach or suggest or motivate the present invention of two distinctive, independent games.

The Examiner argues “it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the lotto game of Mullins onto an electronic gaming device as taught by Marnell”, (Office Action, p. 6), but this is precisely *not* the present invention. At best, combining Mullins and Marnell suggests playing on an apparatus a jackpot game associated with a corresponding instant win game such that each instant-win game is played in combination with the jackpot game such that any corresponding winning instant game becomes a bonus game. “A reference will teach away if it suggests that the line of development flowing from the reference's disclosures is unlikely to be productive of the result sought by the applicant.”

See In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994).

Contrary to the Examiner, there is no teaching, suggestion or motivation to combine a preprinted lottery ticket of Mullins with an electronic poker game apparatus of Marnell. Although Marnell discloses an electronic gaming device to play gambling games like lotto (1:13-15), the jackpot game of Mullins teaches away from incorporation on a gaming machine. The jackpot game of Mullins defines a date on which the jackpot drawing will be held. (3:56-60). It is illogical that a player would sit at a gaming machine in the hopes to match a series of numbers displayed on the machine to numbers resultant from a future drawing.

Furthermore, the present invention is not “an instant type lottery game representing a five card poker game.” (Office Action, p. 6). The combination of Mullins, Marnell and Nelson still do not teach or suggest or motivate the present invention. Nelson is a display providing the realistic appearance of playing real poker. (2:30-67). The game of Nelson further includes a special card illustrated on the display to which the player tries to match an in-hand card. (2:40-

57). Adding Nelson does not fulfill the deficiencies of Mullins and Marnell to suggest the unique combination of two such disparate games on one machine in the manner of Applicants' claims.

Although the references need not expressly teach that the disclosure contained therein should be combined with another, the showing of "combinability" must be "clear and particular." *Ruiz v. A.B. Change Co.*, 234 F.2d 654, 665 (Fed. Cir. 2000). In other words, there must be some teaching or suggestion to "look to particular sources, to select particular elements, and to combine them as combined by the inventor." *Crown Operations Int'l, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 1376 (Fed. Cir. 2002). The line of development flowing from the Mullins and Marnell and Nelson disclosures is unlikely to be productive of the result sought by the Applicants. *See In re Gurley*, 27 F.3d at 553.

Independent Claims 1, 36, 40, 41, 47, 78 and 96 clearly recite "a first game of chance concluding to a monetary prize award, a second game of chance concluding to a non-monetary prize award, wherein the first game of chance is operated in conjunction with the second game of chance and in a manner unrelated (irrespective) to any outcome in the first game", all of which Mullins/Marnell/Nelson fail to teach or suggest. In addition, Mullins/Marnell/Nelson fail to teach or suggest a second game having the potential on every play thereof for achieving a prize award of Claims 1, 41 and 47, "a reel display with a plurality of reels" of Claim 36, "operating said second game ... provided said first wager is of at least a preset type" of Claim 40, "registering an amount bet" to award any winnings "per a payable and said wager" along with a "random selection mechanism" to select prize elements in the second game" of Claim 96.

The Examiner rejected Claims 22, 40 and 42 under 35 U.S.C. §103 as being unpatentable over Mullins in view of Marnell in further view of Nelson in yet further view of U.S. Patent No. 6,685,563 to Meekins et al., ("Meekins"). Reconsideration of the rejection is requested.

Meekins does not fulfill the deficiencies of Mullins/Marnell/Nelson, described and distinguished above. Meekins does not teach operating a first game of chance concluding to a monetary prize award, a second game of chance concluding to a non-monetary prize award, with the first game having a first set of positions for game elements, and the second game having a second set of positions, and first and second sets of game elements that are different, wherein the second game concludes in a manner unrelated to any outcome in the first game. Meekins is a method of operating a wagering game with a base unit and bonus unit (2:45-55). The base unit is played wherein a winning payout increases the player's credits on a credit meter or payout through a coin exit chute (4:42-45). The bonus game initiates when the coin or credit threshold exceeds a predetermined value (4:42-45). The bonus game is dependent on the result occurring in the base game (4:63-64; 6:30-34). A winning condition in the base game increases the player's coins or credits which in turn advances the player to the predetermined threshold value required for playing the bonus game (6:30-34). Moreover, Meekins fails to teach a "first game of chance" and a "second game of chance" that are operated "in conjunction."

In contrast to Applicants foregoing Claims, Meekins does not teach each and every limitation of independent Claims 1, 40 and 41. As distinguished above, independent Claims 1 and 40 are not obvious in view of any combination of the cited references. In addition, dependent Claims 22 and 42 contain further limitations that the cited prior art raised in rejection does not teach or suggest as a whole.

Since the independent Claims are in condition for allowance, all dependent claims thereon are also in condition for allowance.

Quite simply, the present invention is not a lotto game, nor is it a game with corresponding games played in combination wherein a jackpot game turns into a bonus game dependent on matching relationship between the jackpot game and the winning instant game.

The present invention discloses a gaming machine with two entirely separate games of chance. The player can win the second game of chance without obtaining a win in the primary, or first game of chance. Any prize achieved in the second game is awarded, again, irrespective of what happens in the first game. Thus, it is possible for the player to win both the first game of chance and the second game of chance on the first play, or just the second game. But whatever happens in the second game is independent of the first game outcome and the two games are displayed entirely independent of each other. Significantly, the present invention teaches that the secondary game of chance is a game in which a non-monetary prize can be achieved to differentiate it from the monetary-based primary game.

Allowable Subject Matter

Applicants acknowledge the allowability of Claims 112-113. Allowance of the remaining pending Claims in this application is respectfully requested.

Respectfully submitted,

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